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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/047,122	01/15/2002	John I. Shipp	115.0001-00000	9694
22882	7590	12/30/2003		
MARTIN & FERRARO, LLP 1557 LAKE O'PINES STREET, NE HARTVILLE, OH 44632			EXAMINER O CONNOR, CARY E	
			ART UNIT	PAPER NUMBER
			3732	

DATE MAILED: 12/30/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/047,122

Applicant(s)

SHIPP ET AL

Examiner

Cary E. O'Connor

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10-16-03.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-11, 13-23, 25, 26, 28-36, 38-59, 61-87 and 89-116 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 6-11, 13-23, 25, 26, 28-36, 38-59, 61-72, 77-86, 89-92 and 99-116 is/are allowed.
- 6) ☒ Claim(s) 1-5, 73-76, 87 and 93-98 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

DETAILED ACTION

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1, 5, 95, 97 and 98 are rejected under 35 U.S.C. 102(a) as being anticipated by McGuckin, Jr. (6,280,450). McGuckin shows a surgical extractor comprising a body having a leading end, a trailing end, a longitudinal axis and a lumen between the ends. A dilator 208 is located at the leading end of the body and is movable between an unexpanded position and an expanded position (see Figures 7 and 8). A cover 216 extends from the leading end of the dilator and is adapted to capture tissue prior to extraction from the patient. A draw cable 219 runs through the lumen of the body and out the trailing end and is adapted to move a portion of the cover away from the dilator and toward a mid-longitudinal axis of the extractor (see Figure 14). As to claim 5, the maximum cross-sectional dimension of the body is smaller than the expanded cross-sectional dimension of the dilator, as can be seen in Figure 8.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 2-4 are rejected under 35 U.S.C. 103(a) as being unpatentable over McGuckin, Jr. (6,280,450) in view of Stevens (5,643,227). McGuckin does not show a seal in the lumen of the body. Stevens shows a two part seal wherein the first part 22a seals the lumen when the instrument is inserted into the lumen and the second part 22b seals the lumens when the instrument is removed from the lumen. This arrangement reduces leakage through the seal. It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the body of McGuckin with a two part seal, as taught by Stevens, in order to prevent leakage during the procedure.

Claims 73-76 are rejected under 35 U.S.C. 103(a) as being unpatentable over Richard (6,383,195 B1) in view of Zakko (5,527,274). Richard discloses a method for removing tissue from a body cavity comprising all the claimed steps except the use of MTBE to at least partially dissolve the tissue before removal. Richard uses a surgical extractor comprising a body 50 having a leading end, a trailing end, a longitudinal axis and a lumen between the ends. A dilator 15 is located at the leading end of the body and is movable between an unexpanded position (Fig. 1) and an expanded position

(Fig. 2). Zakko teaches that it is well known to use MTBE to dissolve gallstones without injury to the gallbladder (see "Background of the Invention"). It would have been obvious to one of ordinary skill in the art at the time the invention was made to include a step of treating the tissue of Richard with MBTE, as taught by Zakko, if the tissue is too large to remove from the small passage into the body.

Claims 87, 93 and 94 are rejected under 35 U.S.C. 103(a) as being unpatentable over Heidmueller (5,281,230). Heidmueller shows a surgical extractor for removing tissue from a body cavity comprising a body 10 having a leading end, a trailing end, a longitudinal axis and a lumen between the ends. Guiding tube 1 is considered a cannula and has a lumen for accepting the instrument. A dilator (bowls 2, 3) is located at the leading end of the body and is movable between an unexpanded position and an expanded position. As to claim 5, the maximum cross-sectional dimension of the body is smaller than the expanded cross-sectional dimension of the dilator, as can be seen in Figure 1a. As to claim 94, the extractor may be used to aspirate material from a body cavity (column 2, lines 22-24) via lumen 19. As to claim 87, tissue, i.e. the gallbladder, may be grasped by the dilator in order to remove it from the body. Without a showing of criticality, the dimensions of the various parts of the instrument are considered to have been obvious design choices, to one of ordinary skill in the art, depending on the procedure being performed.

Claim 96 is rejected under 35 U.S.C. 103(a) as being unpatentable over McGuckin, Jr. (6,280,450) in view of Chu et al (2002/0068943). McGuckin does not disclose that the cover is made from a breathable material. Chu shows an extractor

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with a cover 24 which may be made from a breathable material (paragraph 0094, lines 9-13). It would have been obvious to one of ordinary skill in the art at the time the invention was made to make the cover of McGuckin of a breathable material, in view of Chu, in order to allow small particles to pass through.

Allowable Subject Matter

Claims 6-11, 13-23, 25, 26, 28-36, 38-59, 61-72, 77-86, 89-92, 99-116 are allowed.

Drawings

The corrected or substitute drawings were received on October 16, 2003. These drawings are approved.

Response to Arguments

Applicant's arguments with respect to claims 1 and 73 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the


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shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Cary E. O'Connor whose telephone number is 703-308-2701. The examiner can normally be reached on M-Th, 6:30-4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kevin Shaver can be reached on 703-308-0858. The fax phone numbers for the organization where this application or proceeding is assigned are 703-308-2708 for regular communications and 703-308-2708 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0858.


Cary E. O'Connor
Primary Examiner
Art Unit 3732

ceo
December 11, 2003